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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,911	09/26/2003	Michael J. Sullivan	P-3170-1-1-F2-2-C1-C1-D1	9194

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,911

Applicant(s)

SULLIVAN ET AL.

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 13-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 13-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Parent applications 7-559177 and 8-645185 each lack basis for blends of two or more of the olefin/acrylate/acrylic acid terpolymer ionomers). Application 7-865212 lacks support for the high amounts of soft ionomer. Therefore, claims 1,13-22 and 26 have effective filing dates of 8/6/92.

Applicant is advised that should claim 15 be found allowable, claim 26 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 13-30 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The acrylate ester is said to have "2 to 22 carbons" in the independent claims. However, acrylates at a minimum must have 4 carbons. What does a 2 carbon acrylate ester look like? Note that this discrepancy was raised in the Board of Appeals Decision 200-0062 during prosecution of parent application 8-645185.

Claim 17 terms the terpolymer ionomer "hard". This is not in agreement with applicant's own specification (see page 14 of spec). Note if "hard" is replaced with "soft", this claim will be identical to claims 15 and 26.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,13,15-18 and 23-27 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the FR2625909 Patent.

The examiner relies on US4884814 as a translation of the French document.

The reference exemplifies (#9,10,12) blends of large amounts of surlyn AD8269 and surlyn AD8265 with lessor amounts of “hard” ionomers such as surlyn9910. Surlyn 9910 qualifies as applicant’s hard ionomer (see table 1 of the reference). The surlyn AD ionomers are soft ionomers of ethylene/acrylate/methacrylic acid having applicant’s physical properties (see table 1 of reference). The surlyn AD ionomers are methacrylic acid based rather than acrylic acid based. However, the reference teaches any unsaturated C3-C8 acid can used in the soft ionomer (col 4 line 51). One of ordinary skill in the ionomer and golf ball arts recognize methacrylic acid and acrylic acid as the

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two most common acids in ionomer covered golf balls. Use of other acids is extremely rare. One of ordinary skill would immediately envisage using acrylic acid or methacrylic acid from the disclosure of "C3 to C8 monocarboxylic acid". Note that the Board of Appeals Decision 2000-0062 in parent 8-645185 upheld the principle that acrylic acid is anticipated and obvious from the reference's disclosure.

Claims 1,13,15-18 and 23-27 rejected under 35 U.S.C. 103(a) as being unpatentable over FR2625909 in view of Research Disclosure 27103.

FR2625909 does not explicitly recite "acrylic acid" for use in making the soft ionomer. The research disclosure explicitly teaches that both methacrylic and acrylic acid can be used in forming soft ionomers. It would have been obvious to use either acid when making the soft ionomers of FR2625909. Note that the Board of Appeals Decision 2000-0062 in parent 8-645185 upheld the principle that acrylic acid is obvious from the combination of references.

Claims 1 and 13-30 rejected under 35 U.S.C. 103(a) as being unpatentable over FR2625909 in view of Molitor '193 and optionally Research Disclosure 27103.

FR2625909 does not specify any compositional details of his core other than it is made of polybutadiene (col 6 line 61). Polybutadiene, ZnO, stearic acid, Zn diacrylate cores are conventional core materials (see Molitor col 7). It would have been obvious to employ the conventional cores in the FR2625909 ball.

Claim 1 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stefani '972.

Stefani exemplifies (table 1 #A) a golf ball cover of 25% surlyn8118, 25% surlyn8269 and 50% surlyn 8265. Surlyn8118 is a lithium based ethylene/acid ionomer of 61,000psi (col 3 line 44). Its individual shore D is about 69 (see example F). This qualifies as applicant's hard ionomer. Surlyn 8269 and 8265 are inherently sodium based soft ionomers of ethylene/acrylate/methacrylic acid terpolymers of low flex modulus and low shore D (see table 1 of Sullivan '814; table 4 of spec). Stefani teaches the soft ionomer can be made of acrylic acid instead of methacrylic acid (see claim 10). Such a modification to the example composition would be obvious if not considered anticipated. Note that the exemplified 25/75 ratio is indistinguishable from a "less than 25/75" ratio in any meaningful sense. Also note Stefani permits larger amounts of sodium ionomer (col 6 line 48).

Claims 1,13 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Stefani '972 in view of Molitor '193.

Stefani does not specify any compositional details of his core. Polybutadiene, ZnO, stearic acid, Zn diacrylate cores are conventional core materials (see Molitor col 7). It would have been obvious to employ the conventional cores in the Stefani's ball.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,15-17 and 23-26 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6193616. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent also claims golf ball cover of at least one hard ionomer and at least one soft ionomer. "at least one " renders obvious two or more.

Claims 1 and 13-30 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6193616 in view of Molitor '193. The claims of the patent do not specify any compositional details of the core. Polybutadiene, ZnO, stearic acid, Zn diacrylate cores are conventional (see Molitor col 7). It would have been obvious to employ the conventional cores in the patent's ball.

Claims 1,15-17 and 23-26 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6676537. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent also claims golf ball cover of at least one hard ionomer and at least one soft ionomer. "at least one " renders obvious two or more.

Claims 1 and 13-30 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No.

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6676537 in view of Molitor '193. The claims of the patent do not specify any compositional details of the core. Polybutadiene, ZnO, stearic acid, Zn diacrylate cores are conventional (see Molitor col 7). It would have been obvious to employ the conventional cores in the patent's ball.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

3/9/05

DAVID J. BUTTNER
PRIMARY EXAMINER

David Buttner